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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,233	12/02/2003	Gino A. Scribano	CE10726R	3718
22917	7590	06/01/2007		
MOTOROLA, INC. 1303 EAST ALGONQUIN ROAD IL01/3RD SCHAUMBURG, IL 60196			EXAMINER VUONG, QUOCHIEN B	
			ART UNIT 2618	PAPER NUMBER
			NOTIFICATION DATE 06/01/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Docketing.Schaumburg@motorola.com
APT099@motorola.com

Office Action Summary	Application No. 10/726,233	Applicant(s) SCRIBANO ET AL.	
	Examiner Quochien B. Vuong	Art Unit 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 and 9 is/are rejected.
- 7) ☒ Claim(s) 3 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>03/23/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 03/23/2007 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 4-7, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang (US 7,130,285).

Regarding claim 1, Chang (figure 8; column 9, line 11- column 10, line 32) discloses in a communication system comprising a source base station, a target base station and a mobile switching center, a method of improving hard handoff comprising:

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by the source base station, sending a request for handoff to the mobile switching center, wherein the request comprises a requested service option and a list of service options supported by a mobile station (column 9, lines 11-43); receiving by the source base station, a handoff command comprising a service option selected by the target base station, wherein the selected service option comprises one of the requested service option and a service option in the list of service options supported by the mobile station (column 10, lines 11-20); and sending, by the source base station, a handoff direction message containing the selected service option to the MS (column 10, lines 21-32).

As to claim 2, Chang discloses wherein the request for handoff recommends a hard handoff to one or more cells in a domain of the target base station (column 9, line 11- column 10, line 32).

Regarding claim 4, Chang (figure 8; column 9, line 11- column 10, line 32) discloses in a communication system comprising a source base station, a target base station and a mobile switching center, a method of improving hard handoff comprising: by the target base station, receiving a request for handoff wherein the request comprises a requested service option and a list of service options supported by a mobile station (column 9, lines 11-43); determining whether the requested service option is supported; when the requested service option is not supported, selecting an alternate service option; when the requested service option is supported, selecting the requested service option (column 9, line 44 - column 10, line 20); and sending, by the target base station, a handoff request acknowledge comprising the selected service option (column 10, lines 21-32).

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As to claim 5, Chang discloses wherein the step of selecting an alternate service option comprises selecting the alternate service option based on one or more of a MS's service option capabilities, service option priorities, and resources available in the target base station (column 9, line 11- column 10, line 32).

As to claim 6, Chang discloses sending a handoff request acknowledge message to the mobile switching center, wherein the message comprises the selected service option (column 9, line 11- column 10, line 32).

Regarding claim 7, Chang (figure 8; column 9, line 11- column 10, line 32) discloses in a communication system comprising a source base station, a target base station and a mobile switching center, a method of improving hard handoff comprising: receiving, by the mobile switching center, a request for handoff from the source base station, wherein the request comprises a requested service option and a list of service options supported by a mobile station (column 9, lines 11-43); and sending, by the mobile switching center, a handoff request message to the target base station, wherein the request message comprises the requested service option and the list of service options supported by the mobile station (column 9, lines 28-58).

As to claim 9, Chang discloses receiving a handoff request acknowledge message comprising a service option selected by the target base station; preparing to switch from the source base station to the target base station; and sending a handoff command to the source base station, wherein the command comprises the service option selected by the target base station (column 10, lines 11-32).

Allowable Subject Matter

4. Claims 3 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 3, Chang disclose a method of claim 1, however, Chang fails to further disclose the method above wherein the list of service option is prioritized according to a preference of the mobile station.

Regarding claim 8, Chang disclose a method of claim 7, however, Chang fails to further disclose the method above wherein the step of sending comprises: removing one or more unauthorized service options from the list of service options supported by the mobile station to produce a list of mobile supported and authorized service options; and sending a handoff request message to the target base station, wherein the message comprises the requested service option and the list of mobile supported and authorized service options.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quochien B. Vuong whose telephone number is (571) 272-7902. The examiner can normally be reached on M-F 9:30-18:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on (571) 272-7882. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Quochien B. Vuong
May 29, 2007.

QUOCHIE B. VUONG
PRIMARY EXAMINER